

Atty's Docket — Belersdorf 733
USSN 09/909 311
Heiner MAX, et al.,

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 24 - 38 are in the application.

Claims 24-26 and 28-29 have been rejected as allegedly anticipated by Sanchez.

Claims 27 and 30-38 are rejected as allegedly being obvious over Sanchez.

In response, Applicants have amended claims 24-25 and 31-35. Claims 26 and 30 have been canceled.

The amendments to independent claims 24 and 25 are believed to overcome the rejections. In brief, the amendments achieve two goals. First, they narrow the independent claims substantially by reciting specific oil phase components that are not taught or suggested in Sanchez. Further, these specific oil phase components must be present in fixed weight ratio with the cyclodextrin component.

Anticipation

Sanchez's disclosure of cyclodextrin compositions being creams, lotions, etc. do not provide anything more than a recitation of several genera of additives -- waxes, oils, latexes, etc. See col. 5, lines 12-21. It is long standing practice that such broad descriptions cannot anticipate a claim reciting species unless that

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disclosure permits those of ordinary skill in the art to *at once envisage from the formula* the exact chemical species being claimed. MPEP § 2131.02

Sanchez does not even disclose specific subgenera of the broadly descriptive groups such as solvents, oil, etc. Sanchez's disclosure does not even provide a single preferred embodiment having an oil phase. This is due to the fact that Sanchez actually specifies an overwhelming preference for aqueous, non-oily compositions. In considering these facts in view of the amendments, Sanchez cannot reasonably be seen as anticipating the claims.

Withdrawal of the rejection under § 102 is requested.

Obviousness

In the final office action, Examiner stated that the claims were obvious because *inter alia*, the broad recitation of oils and waxes "clearly read on the instant oily components recited in claim 38 herein." Office action, paper 18, top page 6. This is not correct for the same reasons provided in the discussion of anticipation.

"To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996)." MPEP § 2144.08.

Amended claims 24-25 provide species of components that are not even generically disclosed. Thus, the facts presented here are even more clearly skewed in the Applicants' favor. This is because the PTO guidelines imply that without Sanchez disclosing a chemically defined genus, species cannot be rendered obvious.

In addition to reciting the specific oil phase component, the claims also fix a specific ratio for the wt.-% of cyclodextrins-to-specific oil phase component(s). This

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cannot reasonably be viewed as suggested by Sanchez when he does not even disclose these particular components or any oil containing embodiments.

Sanchez's complete absence of disclosure also indicates that the newly claimed range of wt.-% ratios is not the result of routine optimization of a result-effective variable. It is noted that MPEP 2144.05 section II (Optimization of Ranges) states "*A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).*"

In view of the amendments and foregoing remarks, withdrawal of the rejection under § 103 and § 102 is requested.

Respectfully Submitted,

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